

Application No.: 10/726,618
Attorney Docket No. 52493.000310

REMARKS

The Office Action has been received and carefully considered. Claims 1-18 are pending in the present patent application. In this response, claim 17 is amended. Claim 17 is amended to further define Applicant's claimed invention.

No new matter has been introduced by this Amendment. Support for the amendment may be found on pages 8-10 of the application. Entry of the amendments to the claims is respectfully requested.

Reconsideration of the current rejections in the present application is respectfully requested based on the following remarks.

A. Applicant's Arguments filed February 5, 2009

The Office Action, in paragraph 10 asserts:

10. Applicant's arguments filed 05 February 2009 have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Applicant understands that Applicant's 05 February, 2009 Arguments were persuasive to the extent as to prompt the new grounds of rejection as set forth in the present Office Action.

Applicant requests clarification, if such understanding by Applicant is misplaced.

B. 35 U.S.C. 101

Applicant notes the withdrawal of the prior 35 U.S.C. 101 rejection, as reflected in paragraph 5 of the Office Action.

C. The 35 U.S.C. 103 Rejection Based on Lerner and Ghouri

On page 3 of the Office Action, claims 1, 3-5, 7-9, 11-13, 15, and 16 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent Application Publication No.

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2002/0087364 to Lerner *et al.* ("Lerner") in view of U.S. Patent Application Publication No. 2004/0049506 to Ghouri. This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or "secondary considerations," of non-obviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); see also KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). An "expansive and flexible approach" should be applied when determining obviousness based on a combination of prior art references. KSR, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. Id. at 1741. Rather, there must still be some "reason that would have prompted" a person of ordinary skill in the art to combine the elements in the specific way that he or she did. Id.; In re Icon Health & Fitness, Inc., 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. KSR, 127 S. Ct. at 1740-41.

The Grounds of Rejection is Unclear

The Office Action sets forth various assertions as to the alleged teachings of Lerner and Ghouri. In particular, on pages 3-4, the Office Action asserts that Lerner teaches a method comprising the steps of:

- ...
 - making at least one insurance underwriting decision **based on the consistency** between the medication information and the medical condition information; (see at least Lerner [0024] "A total risk factor or eligibility score is

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calculated by adding the individual assessment values assigned to the potential customer at step 162 after review of the medical and application information. This total score represents a comprehensive quantified assessment of the potential customer insurability, and is used to make decisions on whether or not to underwrite a life insurance policy")

(emphasis added)

However, on page 4, lines 7-10 of the Office Action, the Office Action acknowledges the deficiencies of Lerner. That is, the Office Action acknowledges that Lerner does not disclose:

- assessing a **consistency** between the medication information and the medical condition information, the assessing consistency between the medication information and the medical condition information performed by the processor; (see at least Ghouri [0019] Fig:1,2 & related text)

Applicant submits that the rejection is flawed. The assertions above that Lerner teaches "making at least one insurance underwriting decision **based on the consistency** between the medication information and the medical condition information pages" effectively presupposes that Lerner indeed possesses the "consistency" parameter, i.e., from an analysis perspective Lerner must possess such parameter to indeed manipulate such parameter as purported in the Office Action. However, on page 4, lines 7-10 of the Office Action as set forth above, the Office Action acknowledges that Lerner indeed does not possess such "consistency" parameter. Thus, the analysis under 35 U.S.C. 103 is deficient in a fundamental manner.

Further, on page 11, lines 13-18, the Office Action again relies on alleged teachings of Lerner that the Office Action has clearly acknowledged Lerner does not possess.

Thus, the 35 U.S.C. 103 rejection is confusing in that the basis of the rejection is unclear. Specifically, the Office Action fails to clearly set forth the alleged teachings of Lerner and Ghouri and the manner in which those alleged teachings purport to render obvious the claimed invention.

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As articulated in the recent Federal Register guidelines:

Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed. Clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office Action leads to the prompt resolution of issues pertinent to patentability. Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* Federal Register vol. 72, No. 195, Wednesday, October 10, 2007, page 57527.

The present rejection simply fails to articulate sufficient findings of fact to support the rejection.

Thus, the rejection recites conclusory statements, which cannot sustain an obviousness rejection.

In re Kahn, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). Applicants respectfully request that the rejection under 35 U.S.C. 103 be withdrawn.

The Teachings of Lerner and Ghouri

Applicant further submits that the teachings of the applied art to Lerner and Ghouri fail to support the 35 U.S.C. 103 rejection.

In Applicant's prior response, Applicant further argued as to Lerner's deficiencies.

Applicant asserted:

Also, the Examiner asserts that Lerner discloses "assessing a consistency between the medication information and the medical condition information, as presently claimed. In particular, the Examiner alleges that a server system of Lerner quantitatively assesses and analyzes the information to determine an eligibility score or value with respect to the insurability issues of interest as disclosing "assessing a consistency between the medication information and the medical condition information," as presently claimed. Applicant respectfully disagrees. Applicant submits that Lerner discloses the server system employs an algorithm based on insurer underwriting criteria to evaluate the medical information retrieved from databases 8 and the information provided by the potential customer and produce the underwriting score or value. *See, e.g.*, paragraph [0024]. Moreover, Lerner discloses a total risk factor or eligibility score is calculated by adding the individual assessment values assigned to the potential customer after review of the medical and application information. *See, e.g.*, paragraph [0024]. Nowhere does Lerner disclose that the algorithm used by the server system "assessing a consistency between the medication information and the medical condition information," as presently claimed. Furthermore, Lerner provides example of underwriting criteria may assign

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points based on medical test results or other information. By way of example, low blood pressure may be assigned one point, moderate blood pressure may be assigned three points and high blood pressure may be assigned five points. *See, e.g.,* paragraph [0024]. Therefore, Applicant respectfully submits that Lerner merely discloses a underwriting score and fails to disclose "assessing a consistency between the medication information and the medical condition information," as presently claimed.

In the prior Office Action, the Examiner responded to Applicant's arguments. In particular, on page 18, the Office Action asserts:

Applicant also argues that Lerner does not anticipate "assessing a consistency between the medication information and the medical condition information". In response to applicant's argument, a recitation of the **intended use** of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Examiner asserts, as the Applicant has conceded, that the invention disclosed in Lerner **employs an algorithm to evaluate medical criteria**. The Examiner takes the position that this limitation of Lerner is **fully capable** of "assessing a consistency between the medication information and the medical condition information".

(emphasis added)

In response, Applicant argued that the Office Action's reliance on "intended use" was misplaced, and that the claimed feature of "assessing a consistency between the medication information and the medical condition information" cannot appropriately be interpreted as intended use.

In the present Office Action, while the rejection no longer relies on intended use, the Office Action has failed to address the acknowledged deficiencies of the applied art.

The claimed feature of "assessing a consistency between the medication information and the medical condition information" should be interpreted fairly and appropriately. Applicant submits that such feature, under a reasonable and appropriate interpretation, requires a comparison, of some nature, to be drawn. That is, "assessing a consistency" in a fundamental manner requires that the medication information and the medical condition information, i.e., two pieces of information, are compared in some manner.

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The Office Action asserts on page 4 that Ghouri teaches:

- assessing a consistency between the medication information and the medical condition information, the assessing consistency between the medication information and the medical condition information performed by the processor; (see at least Ghouri [0019] Fig.1,2 & related text)

(emphasis added)

In the referenced paragraph 19 of Ghouri, Ghouri sets forth:

[0019] In general, physicians evaluate certain attributes, which are commonly termed Major Clinical Characteristics, of a pharmacotherapy regime, when determining which medication is optimal for a patient. These major clinical characteristics include a drug's safety, efficacy, cost, dosing convenience, formulary insurance coverage, side effect profiles, and FDA approval for the intended use (e.g., for a given diagnosis, pediatric use, etc). Furthermore, within the realm of the safety attribute, there are specific sub-types of interactions which create safety risks and must, therefore be taken into consideration. These include (a) drug-drug interactions, (b) drug-disease interactions, (c) status interactions such as interactions in pregnancy, (d) interactions if breastfeeding, (e) drug-medical condition interactions, and (e) interactions in allergic states, either primary to the specific drug or cross sensitivity to a related drug for which the patient has known allergy. Examples of drug-medical condition interactions might include exacerbated responses or risks in a particular ethnic group or in patients with a particular laboratory finding which may not be considered a disease, but is clinically significant nevertheless. In the case of pregnancy, each drug is classified by the FDA as having a pregnancy risk category from A to X, and is similarly stratified for risk in breastfeeding (lactating) mothers into distinct categories.

(emphasis added)

Applicant respectfully submits that such disclosure of Ghouri clearly fails to teach the "assessing a consistency between the medication information and the medical condition information" as alleged in the Office Action. Indeed, such disclosure appears to disclose little more the typical assessment of a particular medication to use. Further, the referenced Figs. 1 and 2 of Ghouri appear no more relevant. In particular, the assessment (as described in Fig. 2 of Ghouri) differs from the claimed feature in which two pieces of information, from the applicant, are compared, i.e., Applicant submits that even broadly interpreted the claimed feature requires some type of comparison, albeit indirect, to be performed between the medication information

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and the medical condition information. Ghouri fails to teach such, and thus fails to cure the acknowledged deficiencies of Lerner.

Regarding claims 3 and 4, these claims are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 3 and 4 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

Regarding claims 5, 9, and 13, these claims recite subject matter related to claim 1. Thus, at least some of the arguments set forth above with respect to claim 1 are equally applicable to claims 5, 9, and 13. Accordingly, it is respectfully submitted that claims 5, 9, and 13 are allowable over Lerner for the same reasons as set forth above with respect to claim 1.

Regarding claims 7, 8, 11, 12, 15, and 16, these claims are dependent upon independent claims 5, 9, and 13. Thus, since independent claims 5, 9, and 13 should be allowable as discussed above, claims 7, 8, 11, 12, 15, and 16 should also be allowable at least by virtue of their dependency on independent claims 5, 9, and 13. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of the claims be withdrawn.

D. The Further 35 U.S.C. 103 Rejection

On page 8 of the Office Action, claims 2, 6, 10, 14, 17, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No.

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2002/0087364 to Lerner *et al.* ("Lerner") in view of U.S. Patent Application Publication No. 2001/0032099 to Joao in further view of Ghouri.

Regarding claim 17, this claim recites subject matter related to claim 1. Thus, the arguments set forth above with respect to claim 1 are equally applicable to claim 17. Accordingly, it is respectfully submitted that claim 17 is allowable over Lerner and Ghouri in view of Joao for the same reasons as set forth above with respect to claim 1.

It is respectfully submitted that the aforementioned obviousness rejection of claims 2, 6, 10, 14, and 18 is moot in view of the deficiencies of the primary reference (i.e., Lerner) as discussed above with respect to independent claims 1, 5, 9, 13, and 17. That is, claims 2, 6, 10, 14, and 18 are dependent upon independent claims 1, 5, 9, 13, and 17 and thus inherently incorporate all of the limitations of independent claims 1, 5, 9, 13, and 17. Also, the further reference (i.e., Joao) fails to disclose, or even suggest, the deficiencies of the applied art as discussed above. Indeed, the Examiner does not even assert such. Thus, the combination of the Joao reference with Lerner and Ghouri also fails to cure the deficiencies as discussed above.

Accordingly, claims 2, 6, 10, 14, and 18 should be allowable at least by virtue of their dependency, as well as the additional features such claims recite.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection under 35 U.S.C. 103 be withdrawn.

F. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the

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present application to issue, if any comments, questions, or suggestions arise in connection with the present application.


To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50 0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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